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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,742	06/21/2001	Emerson Keith Colyer	IN-5486	6026

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,742

Applicant(s)

COLYER ET AL.

Examiner

Tatyana Zalukaeva

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17, 24-35 **stand** rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,518,338. The only difference between claim 1 of No. '338 and the

Art Unit: 1713

instant claim 1 is that the No. '338 recites alkyd resin. However, by the virtue of the word comprising each claim 1 allows even major components in even major amounts.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Molecular Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim clear coating composition comprising identical ingredients wherein the ranges of those components overlap with the ranges as instantly claimed.

3. The instant Application and U.S. 6,518,338 are currently commonly owned, have different inventive entities, but there is no showing of common ownership at time of Applicant's invention.

Commonly assigned U.S. Patent 6, 518,338, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case

Art Unit: 1713

qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, **the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter.** Failure to comply with this requirement will result in a holding of abandonment of the application.

OG Notice of 12/26/01 "Guidelines Setting Forth a Modified Policy the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)" which states:

"Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."

4. A showing that the inventions were commonly owned at the time the invention in this application was made **will preclude** a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

Art Unit: 1713

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 4-13, 15-18, 20-35 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jouck et al (U.S. 5,322,715).

Jouck discloses base coat composition, which contains an emulsion polymer as a film forming material. The basecoat coating compositions according to Jouck' invention may contain as pigments inorganic colored pigments such as, for example, titanium dioxide, iron oxide, **carbon black** etc., organic colored pigments as well as the customary metal pigments (for example, commercial aluminum bronzes, stainless steel bronzes . . .) and non-metallic effect pigments (for example nacreous luster pigments and interference pigments). The basecoat coating compositions preferably contain metal pigments and/or effect pigments. The degree of pigmentation lies within the customary range, preferably 0 to 10% by weight, based on the total weight of the basecoat coating composition (column 12, lines 34-46). The polymer of Jouck is prepared by two stage polymerization. In the first stage 10 to 90, preferably 35 to 65 parts by weight of an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers are emulsion polymerized (col. 5, lines 27-30). The first stage a1) 100 to 60, preferably 99.5 to 75% by weight of a cycloaliphatic or aliphatic ester of methacrylic acid or acrylic acid or a mixture of such esters and

Art Unit: 1713

a2) 0 to 40, preferably 0.5 to 25% by weight of a monomer which is copolymerizable with (a1) or a mixture of such monomers (col. 5, lines 6-12).

Examples of monomers which can be used in the second stage, are as follows:

vinylaromatic hydrocarbons esters of the acrylic acid or methacrylic acid, in particular aliphatic and **cycloaliphatic acrylates or methacrylates** having up to 20 carbon atoms in the alcohol radical, such as, for example, methyl, ethyl, propyl, butyl, hexyl, ethylhexyl, stearyl, lauryl and **cyclohexyl acrylate** or 2-hydroxyethyl acrylate,

2-hydroxypropyl acrylate, 3-hydroxypropyl acrylate, 2-hydroxypropyl methacrylate, 3-hydroxypropyl methacrylate, etc. A mixture consisting of

(b1) 47 to 99, preferably 75 to 90% by weight of a cycloaliphatic ester of methacrylic acid or acrylic acid

(b2) 1 to 20, by weight of a monomer which is copolymerizable with (b1), (b3) and (b4) and carries at least one hydroxyl group or a mixture of such monomers

(b3) 0 to 8, preferably 2 to 6% by weight of a monomer which is copolymerizable with (b1), (b2) and

((b4) 0 to 25, preferably 2 to 15% by weight of a further monomer which is copolymerizable with (b1), (b2) and (b3) (col. 6, lines 1-20 and 26-46)

The emulsion polymer of Jouck has Mn higher than 200,000 (col. 6, lines 60-62) and hydroxyl number is 2-100 mg KOH /g (col. 6, lines 64, 65).

Further crosslinked polymeric microparticles can be added and/or customary inorganic or organic additives discussed in details in col. 12, lines 46-66.

Art Unit: 1713

Therefore the limitations of the instant claims 1, 4-13, 15-18, 20-35 are met by the disclosure of Jouck.

In the alternative this rejection is made in the sence of 35 USC 103(a), stating that the refinish property of the basecoat composition of Jouck will be either inherent or obvious to a person skilled in the art since the composition of Jouck is essentially the same the instantly claimed composition. The burden to show that this, in fact, is not the case is shifted to applicants as per *In re Fitzgerald* (205 USPQ 594). (CAFC) .

7. Claims 1-35 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benefiel et al (U.S. 3,639,147).

Benefiel discloses a pigmented cellulose containing base coat composition (abstract). The base coat composition comprises a combination of a crosslinking agent and suitable carboxy-hydroxy acrylic copolymers are copolymers of 0.15 to 8 weight percent of a polymerizable monoethylenically unsaturated carboxylic acid, 3. 5 to 75 weight percent of a **beta-hydroxyalkyl ester of a polymerizable monoethylenically unsaturated carboxylic acid** and another different monomer polymerizable therewith. This copolymer preferably should include: 61. 0.15 to 8 weight percent (more preferably 0.15 to 4 weight percent) of an unsaturated aliphatic acid selected from at least one member of the group consisting of acrylic acid, methacrylic acid, crotonic acid, itaconic acid, and half acid-esters of maleic and fumaric acids formed with saturated alcohols having from one to 10 carbon atoms, 17 to 94.8 weight percent of at least one different ethylenically unsaturated monomer of the individual material selected in (1) which is copolymerizable with the unsaturated acid of (1) 83. 5 to 75 percent of a beta hydroxy

Art Unit: 1713

alkyl ester of an unsaturated aliphatic acid selected from at least one member of the group consisting of acrylic acid, methacrylic acid, crotonic acid, and half acid-esters of the total of (1) (2) and (3) being 100 percent (col. 2, lines 61-75, col. 3, lines 1-12) Among monomers that can be copolymerized are cyclic esters of acrylates, such as cyclohexyl Methacrylate exemplified in col. 3, line 45.

With regard to some properties of the base coat polymers that are not elucidated by the disclosure of Benefiel, these properties are believed to be inherent or obvious to a person skilled in the art, since the basecoat compositions of Benefiel are essentially the same as and are made by essentially the same process as instantly claimed compositions. The above rejections were made in the sense of *In re Fitzgerald* or *In re Spada*, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

Response to Arguments

8. Applicant's arguments filed March 6, 2003 have been fully considered but they are not persuasive.

Relative to Jouck et al.:

The crux of Applicants' arguments appears to hinge on the Case Law of *Minnesota Mining and Manufacturing Co. v. Johnson and Johnson Orthopaedics, Inc.*

Art Unit: 1713

and alleges that a "reference cannot anticipate by merely broadly describing technology in a way that generally encompasses the inventions specific parameters.

In response to this, it is the Examiner's position, that the reference to Jouck is even more specific in terms of amounts and characteristics, that the instant independent claims.

Thus, Jouck very specifically discloses mixture consisting of

(b1) 47 to 99, preferably 75 to 90% by weight of a cycloaliphatic ester of methacrylic acid or acrylic acid (*clearly reads on at least 45% of cycloaliphatic monomer of the instant claim 1*)

(b2) 1 to 20, by weight of a monomer which is copolymerizable with (b1), (b3) and (b4) and carries at least one hydroxyl group or a mixture of such monomers

(b3) 0 to 8, preferably 2 to 6% by weight of a monomer which is copolymerizable with (b1), (b2) and

((b4) 0 to 25, preferably 2 to 15% by weight of a further monomer which is copolymerizable with (b1), (b2) and (b3) (col. 6, lines 1-20 and 26-46)

The emulsion polymer of Jouck has Mn higher than 200,000 (col. 6, lines 60-62) (*clearly reads on number average molecular weight of the instant claims*) and hydroxyl number is 2-100 mg KOH /g (col. 6, lines 64, 65).

On page 3 of Paper No. 8, lines 5 and 6, Applicants probably mesread their own claims, because the statement that "Jouck patent does not describe polymers specifically prepared with 45% by weight cycloaliphatic monomers" has little in common

Art Unit: 1713

with the claim language " using AT LEAST (emphasis added-T.Z.) 45% by weight of a cycloaliphatic monomer".

Contrary to Applicants' statement, the disclosure of Jouck does provide a specific composition expressly readable on the instant claims, as discussed above.

In response to Applicants arguments that specific examples of Jouck do not contain cycloaliphatic component, it is noted here, that disclosed examples and preferred embodiments do not constitute a teaching away from a **broader disclosure or nonpreferred embodiments**. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, **including nonpreferred embodiments**. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

With regard to Applicants argument on inherency of some characteristics, the burden was shifted to Applicants to show that such characteristics are not inherent, if so, as per *In re Fitzgerald*, as set forth in the previous Office Action on the merits. The rejection can also be regarded in the sense of **In re Spada**, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), stating that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or **not** these properties are shown or suggested in prior art. In the other words, composition and its

Art Unit: 1713

properties are inseparable, and identical compositions cannot have mutually exclusive properties.

Relative to Benefiel:

Applicants arguments reside in contention that the composition of Benefiel requires cellulose acetate butyrate resins, which the instant composition does not require in order to impart specific properties. However, the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Applicants further argue that Benefiel does not disclose a refinish basecoat composition. In response to this, Applicants attention is drawn to col. 2, lines 62, 63, wherein the basecoat composition is expressly named. With regard to a baking step in Benefiel, it is noted that this step is performed only after applying a top coat on a base coat. However, the nature of a base coat of Benefiel is similar to that of the instant

Art Unit: 1713

claims, therefore, it is a base presumption that it will be operable under the same conditions as instantly claimed, i.e. is capable of being a "refinish" base coat composition. Mere recitation of a newly discovered property or function that is inherently possessed by the things or steps in the prior art does not cause a claim drawn to those things to distinguish over the prior art, consult *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (CAFC 1984).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva, Ph.D, whose telephone number is (703)308-8819. The examiner can normally be reached on 9:00 - 5:30.

Art Unit: 1713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-24-50. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


Tatyana Zalukasva, Ph.D.
Primary Examiner
Art Unit 1713

May 13, 2003